

DOCKET NO: 194701US30



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
DAVID GREENBLATT : EXAMINER: NGUYEN, Q. N.
SERIAL NO: 09/575,707 :
FILED: JULY 20, 2000 : GROUP ART UNIT: 2141
FOR: TELECOMMUNICATIONS :
CONTROL SYSTEM USING DATA
INTERCHANGE

APPEAL BRIEF UNDER 37 C.F.R. § 1.192

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This is an appeal from a Final Office Action mailed August 13, 2004. A Notice of Appeal was timely filed on December 13, 2004.

I. REAL PARTY IN INTEREST

The real party in interest in this appeal is Net2Phone, having an address at 171 Main Street, Hackensack, New Jersey 07601.

II. RELATED APPEALS AND INTERFERENCES

Appellant, Appellant's legal representatives, and the Assignee are aware of no appeals or interferences which will directly affect, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF THE CLAIMS

Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, and 28-54, all of the claims in the application, stand finally rejected and are herein appealed.

IV. STATUS OF THE AMENDMENTS

Appellant received a Final rejection on August 13, 2004. In response, Appellant filed a Request for Reconsideration on November 15, 2004. Having received no Advisory Action, Appellant filed a Notice of Appeal on December 13, 2004. Subsequently, on February 18, 2005, Appellant received an Advisory Action in which the Examiner maintained the rejections of Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, and 28-54. The attached Appendix I reflects the claims as presently pending on appeal.¹

V. SUMMARY OF THE INVENTION

The claimed invention relates to a telecommunications control system that enables a user to talk to a person or company providing information on a computer. To this end, independent Claim 1 recites: a computer program product, comprising: a computer storage medium and a computer program code mechanism embedded in the computer storage medium (Figure 1; paras. [0014]-[0017]); the computer program code mechanism comprising: a first computer code device configured to obtain a Uniform Resource Locator stored in an address bar of a Web browser corresponding to a Web page being displayed to a user by the Web browser of a user-side (paras. [0020]-[0023]); a second computer code device configured to convert, without user intervention, the Uniform Resource Locator into a telephone number corresponding to a location at which a provider of the Web page can be contacted (Figure 4, para. [0023]); and a third computer code device configured to visually identify, without user intervention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user (para. [0024]).

¹ During the preparation of this Appeal Brief, Appellant noticed a typographical error in Claim 1. Accordingly, Appellant has filed an amendment concurrently herewith to address this error. For purposes of this appeal, Appellant assumes that this amendment will be entered, as it merely addresses a typographical informality.

VI. ISSUES

The first issue for review is whether one or more of Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, 31-33, 40-45, and 49-54 are unpatentable over Voit (U.S. Pat. No. 6,104,711, hereafter “the ‘711 patent”) in view of Haitsuka et al. (U.S. Pat. No. 6,505,201, hereafter “the ‘201 patent”) and further in view of DeGolia, Jr. et al. (U.S. Pat. No. 6,411,615, hereafter “the ‘615 patent”) under 35 U.S.C. § 103(a). The second issue for review is whether any of Claims 28-30 and 46-48 are unpatentable over the ‘711 patent in combination with the ‘201 patent and the ‘615 patent and further in combination with Venkatachary et al. (U.S. Pat. No. 6,212,184, hereafter “the ‘184 patent”).² The third issue for review is whether any of Claims 34-39 are unpatentable over the ‘711 patent in view of the ‘201 patent and the ‘615 patent and further in view of Fedorov et al. (U.S. Pat. No. 6,047,060, hereafter “the ‘060 patent”) under 35 U.S.C. § 103(a).

VII. GROUPING OF THE CLAIMS

For the first issue, Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, 31-33, 40-45, and 49-54 stand together. For the second issue, Claims 28-30 and 46-48 stand together. For the third issue, Claims 34-39 stand together.

VIII. ARGUMENT

A. The First Issue, Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, 31-33, 40-45, and 49-54

The outstanding Office Action explicitly rejects Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, 31-33, 40-45, and 49-54 as unpatentable over the ‘711 patent in view of the ‘201 patent and further in view of the ‘615 patent.

Claim 1 recites obtaining “a uniform resource locator stored in an address bar of a web browser corresponding to a web page being displayed to a user by the web browser of

² Appellant notes that the Office Actions sometimes refer to Venkatachary et al. as U.S. Pat. No. 6,411,615 (*see, e.g.,* Advisory Action of February 18, 2005 at page 6).

the user-side”; converting, “without user intervention, the uniform resource locator into a telephone number corresponding to a location at which a provider of the web page can be contacted”; and visually identifying “without user intervention, that the telephone number is known for the uniform resource locator corresponding to the web page being displayed to the user.” Claims 5, 11, and 52-54 recite analogous limitations.

At the outset, in order to establish a *prima facie* case of obviousness, three basic criteria must be satisfied. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.³ Additionally, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant’s disclosure.”⁴ Appellant respectfully submits that none of these requirements have been satisfied in this case.

1. Because There Is No Motivation To Combine The ‘711 Patent With Either The ‘201 Patent Or The ‘615 Patent, The Outstanding Office Action Has Engaged In Improper Hindsight Reconstruction Using Teachings From The Appellant’s Own Specification

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.⁵ In this case, there is no suggestion in the cited references to support the applied combination, or to support the modifications of the references required by the outstanding rejection.

³ See, MPEP § 2143.

⁴ *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

⁵ *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); *see also* MPEP § 2143.01.

As noted above, Claim 1 recites that the obtained URL corresponds to the information displayed in the address bar. In fact, an advantage of the claimed invention is that the visual indication need not be embedded in the web page itself. Thus, it is possible to avoid redesigning existing pages that do not include space for a visual indication and/or which have not yet been re-engineered to have such a visual identification.⁶ Through the claimed invention, it is possible that a third party may manage information about whether a telephone number is known for the URL of the address bar, without the designer of the web page even knowing that such information is being provided.

By way of background, the outstanding Office Action admits that the '711 patent does not teach:

obtaining the name address (i.e., obtaining the URL) from an address bar of a web browser corresponding to a web page being displayed to a user and visually identifying that the telephone number is known for the URL corresponding to the web page being displayed to the user.⁷

In other words, the Office Action admits that the '711 patent does not teach the features of Claims 1, 5, 11, and 52-54. The Office Action attempts to remedy this admitted deficiency by citing two additional references (the '201 patent and the '615 patent).

The Office Action alleges that the '201 patent teaches monitoring URLs in the address bar of a web browser, and cites the '615 patent as visually identifying information in the body of the web document (not information in or about the URL in the address bar). The '201 patent, as stated by the Office Action, relates to URLs *in an address bar*. The '615 patent, as categorized by the Office Action, relates to URLs *in the body of a web document*.

The Office Action does not (and cannot) cite to any teachings in the '615 patent relating to URLs in the address bar of a web browser, as required by the claim. Rather, the

⁶ See, e.g., para. [0005].

⁷ Advisory Action of February 18, 2005, at page 3.

Office Action attempts to modify the teachings of the '615 patent to relate to URLs in an address bar (as described in the '201 patent), which is not contemplated by the '615 patent.

Thus, as the Office Action has not provided any support for the allegation that the combination of the '711 patent, the '201 patent, and the '615 patent would have been obvious to one of ordinary skill in the art, it is evident that the applied combination is the result of hindsight reconstruction in view of the teachings of the Appellant's own specification. Such hindsight reconstruction violates the requirements set forth in MPEP § 2143.01, and is improper.

2. The Applied Combination Of The '711 Patent, The '201 Patent, And The '615 Patent Changes The Principle Of Operation Of The References, In Violation Of MPEP § 2143.01

As set forth in MPEP § 2143.01, "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."⁸ In this case, Appellant respectfully submits that the applied combination of references changes the principles of operation disclosed therein.

As noted above, the '615 patent relates to information *in the body of the web document*, and not in an address bar. Nonetheless, the outstanding rejection is based upon the combination of the '615 patent with the '201 patent, which relates to information in an address bar. As a result, it appears that the information in the body of the web document of the '615 patent is being altered to relate to information in an address bar, as described by the '201 patent.

The proposed modification of the teachings of the '615 patent to relate to information in an address bar, rather than information in the body of a document, changes the principle of operation of the '615 patent. By changing from a reference that embeds the information

⁸ *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (CCPA 1959).

within a web page itself to a reference that does not embed information at all, but rather utilizes an address bar (e.g., the '201 patent), the Office Action is suggesting a modification that completely alters the principle of operation of at least one of the references. There is no evidence that any of the inventors of either the '201 patent or the '615 patent contemplated such a modification.

The need for a modification that changes the principle of operation of at least one of the references used in the combination proves that the combination is not obvious. Consequently, the outstanding rejection has again violated the requirements of MPEP § 2143.01.

3. There Is No *Prima Facie* Case Of Obviousness Because The Applied Combination Does Not Teach All Of The Claim Limitations

To establish a *prima facie* case of obviousness, all the claim limitations must be taught or suggested by the applied references.⁹ In the present case, the applied combination does not teach all of the limitations of independent Claims 1, 5, 11, and 52-54.

As noted above, Claim 1 recites visually identifying, "without user intervention, that the telephone number is known for the uniform resource locator corresponding to the web page being displayed to the user."¹⁰ The outstanding Office Action explicitly admits that this feature is not shown in the '711 patent, and tacitly admits that this feature is not shown in the '201 patent.¹¹

The '615 patent does not visually identify that a telephone number is known for the URL being displayed to the user, as alleged by the outstanding Office Action.¹² At best, the '615 patent visually identifies that the telephone numbers are known for links embedded on

⁹ *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

¹⁰ Claims 5, 11, and 52-54 recite analogous limitations.

¹¹ See, e.g., Advisory Action of February 18, 2005, at page 3.

¹² See *id.*

the web page corresponding to the URL in the address bar. Such visual identification is not the same as the claimed visual identification, because (1) multiple telephone connections may be represented on a same page such that no telephone number corresponds to the URL in the address bar, and (2) the same embedded link could be on two different web pages, such that the telephone number corresponds to the link itself and not to the URL in the address bar.

Thus, as the applied combination of the '711 patent, the '201 patent, and the '615 patent fails to disclose or suggest the features recited in Claims 1, 5, 11, and 52-54, it is respectfully submitted that Claims 1, 5, 11, and 52-54 patentably distinguish over the applied combination.

B. The Second Issue, Claims 28-30 and 46-48

The outstanding Office Action explicitly rejects Claims 28-30 and 46-48 as unpatentable over the combination of the '711 patent with the '201 patent and the '615 patent and further in view of the '184 patent. Claims 28 and 46 depend from Claim 1, Claims 29 and 47 depend from Claim 5, and Claims 30 and 48 depend from Claim 11.

1. The Applied Combination Of The '711 Patent, The '201 Patent, The '615 Patent, and The '184 Patent Does Not Provide A *Prima Facie* Case Of Obviousness

As noted above, the applied combination of the '711 patent, the '201 patent, and the '615 patent is deficient and fails to provide a *prima facie* case of obviousness for independent Claims 1, 5, and 11 for at least three reasons. Appellant respectfully submits that the '184 patent does not remedy the above-identified deficiencies of the applied combination, and is not properly combinable with the '711 patent, the '201 patent, and the '615 patent.

2. The '184 Patent Is Not Relied Upon To Provide The Features Identified As Deficient In The Combination Of The '711 Patent, The '201 Patent, And The '615 Patent

The outstanding Office Action does not rely upon the '184 patent to provide visual identification that a telephone number is known for the URL being displayed to the user,

which is neither taught nor suggested by the combination of the '711 patent, the '201 patent, and the '615 patent. Thus, the Office Action has not provided a *prima facie* case of obviousness for Claims 1, 5, and 11, from which Claims 28-30 and 46-48 depend.

3. The '184 Patent Is Not Analogous Art

Moreover, to rely on a reference under 35 U.S.C. § 103, the reference must be analogous art. As set forth in MPEP § 2141.01(a), "[t]he examiner must determine what is 'analogous prior art' for the purpose of analyzing the obviousness of the subject matter at issue."

In the present case, the Office Action has stated that "In a related art, [the '184 patent] teaches"¹³ However, no support for the assertion that the '184 patent is from "a related art" was provided, and Appellant respectfully submits that the '184 patent is not directed toward the Appellant's field of invention.

As explained in the specification, the present invention is directed to providing a more uniform method of enabling a user to connect to the person or company that is responsible for electronic information displayed on a computer.¹⁴ By contrast, the '184 patent relates to scaleable methods and devices for layer four switching. As described in the Abstract of the '184 patent, the '184 patent addresses problems associated with selective switching of data packets on various types of networks.

The '184 patent does not relate in any way to enabling a user to connect to a person or company that is responsible for electronic information displayed on a computer. Therefore, it is respectfully submitted that the '184 patent is not directed to a field of art analogous to the

¹³ See, e.g., Advisory Action of February 18, 2005 at page 6.

¹⁴ Specification, para. [0006].

field of art of the claimed invention, which results in the conclusion that the outstanding Office Action has violated the requirements set forth for properly combinable references.¹⁵

C. The Third Issue, Claims 34-39

The outstanding Office Action rejects Claims 34-39 over the '711 patent in view of the '201 patent and the '615 patent and further in view of the '060 patent.

1. The Applied Combination Of The '711 Patent, The '201 Patent, The '615 Patent, And The '060 Patent Does Not Provide A *Prima Facie* Case Of Obviousness

As noted above, the applied combination of the '711 patent, the '201 patent, and the '615 patent is deficient and fails to provide a *prima facie* case of obviousness for independent Claims 1, 5, and 11 for at least three reasons. Appellant respectfully submits that the '060 patent does not remedy the above-identified deficiencies of the applied combination.

2. The '060 Patent Is Not Relied Upon To Provide The Features Identified As Deficient In The Combination Of The '711 Patent, The '201 Patent, And The '615 Patent

The outstanding Office Action does not rely upon the '060 patent to provide visual identification that a telephone number is known for the URL being displayed to the user, which is neither taught nor suggested by the combination of the '711 patent, the '201 patent, and the '615 patent. Thus, the Office Action has not provided a *prima facie* case of obviousness for Claims 1, 5, and 11, from which Claims 34-39 depend.

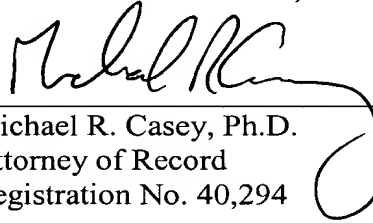
¹⁵ See MPEP § 2141.01(a).

IX. CONCLUSION

Appellant respectfully submits that the cited references do not disclose or suggest the telecommunications control system, method, computer program product recited in Claims 1, 3, 5, 7, 11, 13, 16, 20, 22, 23, and 28-54. Accordingly, it is respectfully requested that all rejections still pending in the Final Office Action be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Michael R. Casey, Ph.D.
Attorney of Record
Registration No. 40,294

Katherine D. Pauley
Registration No. 50,607

Customer Number
22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)

MRC:KDP\la
I:\ATTY\KDP\19'S\194701US\194701US APPEAL BRIEF 5-6-05.DOC

APPENDIX I

1. A computer program product, comprising:
a computer storage medium and a computer program code mechanism embedded in the computer storage medium,
the computer program code mechanism comprising:
a first computer code device configured to obtain a Uniform Resource Locator stored in an address bar of a Web browser corresponding to a Web page being displayed to a user by the Web browser of a user-side;
a second computer code device configured to convert, without user intervention, the Uniform Resource Locator into a telephone number corresponding to a location at which a provider of the Web page can be contacted; and
a third computer code device configured to visually identify, without user intervention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.

2. (Canceled)

3. The computer program product according to claim 1, further comprising a fourth computer code device configured to control a telephone switch to dial the telephone number.

4. (Canceled)

5. A computer-implemented method comprising:
obtaining a Uniform Resource Locator stored in an address bar of a Web browser corresponding to a Web page being displayed to a user by the Web browser at a user-side;

converting the Uniform Resource Locator, without user intervention, into a telephone number corresponding to a location at which a provider of the Web page can be contacted;
and

visually identifying, without user intervention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.

6. (Canceled)

7. The method as claimed in claim 5, further comprising controlling a telephone switch to dial the telephone number.

8-10. (Canceled)

11. A telecommunications system comprising:

a receiver configured to obtain a Uniform Resource Locator stored in an address bar of a Web browser corresponding to a Web page being displayed to a user by the Web browser of a user-side;

a converter configured to convert, without user intervention, the Uniform Resource Locator into a telephone number corresponding to a location at which a provider of the Web page can be contacted;

a controller configured to visually identify, without user intervention, that the telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.

12. (Canceled)

13. The telecommunications system according to claim 11, wherein the controller comprises a telephone switch controller to dial the telephone number.

14-15. (Canceled).

16. The computer program product according to claim 1, further comprising a fourth computer code device configured to establish a voice-over-IP voice communication connection between the user-side and a Web page provider-side.

17-19. (Canceled)

20. The computer-implemented method according to claim 5, further comprising establishing a voice-over-IP voice communication connection between the user-side and a Web page provider-side.

21. (Canceled)

22. The computer-implemented method according to claim 5, further comprising establishing a voice-over-IP voice communication connection across a Wide Area Network between the user-side and a Web page provider-side.

23. The computer-implemented method according to claim 5, further comprising establishing a voice-over-IP voice communication connection across the Internet between the user-side and a Web page provider-side.

24-27. (Canceled)

28. The computer program product according to claim 1, wherein the second computer code device is configured to obtain, from a database, a longest matching sub-string of the Uniform Resource Locator without requiring a complete match of the Uniform Resource Locator to be found in the database.

29. The computer-implemented method according to claim 5, wherein the step of converting comprises obtaining, from a database, a longest matching sub-string of the Uniform Resource Locator without requiring a complete match of the Uniform Resource Locator to be found in the database.

30. The system according to claim 11, wherein the converter is configured to obtain, from a database, a longest matching sub-string of the Uniform Resource Locator without requiring a complete match of the Uniform Resource Locator to be found in the database.

31. The computer program product as claimed in claim 1, wherein the first computer code is further configured to obtain a current Uniform Resource Locator as each new Web page is viewed.

32. The computer-implemented method as claimed in claim 5, wherein the step of obtaining comprises obtaining a current Uniform Resource Locator as each new Web page is viewed.

33. The telecommunications system as claimed in claim 11, wherein the receiver is further configured to obtain a current Uniform Resource Locator as each new Web page is viewed.

34. The computer program product as claimed in claim 1, wherein the third computer code device is further configured to visually identify by causing an icon to flash.

35. The computer-implemented method as claimed in claim 5, wherein the step of visually identifying comprises causing an icon to flash.

36. The telecommunications system as claimed in claim 11, wherein the controller is further configured to visually identify by causing an icon to flash.

37. The computer program product as claimed in claim 1, wherein the third computer code device is further configured to visually identify by causing an icon to change color.

38. The computer-implemented method as claimed in claim 5, wherein the step of visually identifying comprises causing an icon to change color.

39. The telecommunications system as claimed in claim 11, wherein the controller is further configured to visually identify by causing an icon to change color.

40. The computer program product according to claim 1, wherein the second computer code device is configured to obtain the telephone number from a local database.

41. The computer-implemented method according to claim 5, wherein the step of converting comprises obtaining the telephone number from a local database.

42. The system according to claim 11, wherein the converter is configured to obtain the telephone number from a local database.

43. The computer program product according to claim 1, wherein the second computer code device is configured to obtain the telephone number from a remote database.

44. The computer-implemented method according to claim 5, wherein the step of converting comprises obtaining the telephone number from a remote database.

45. The system according to claim 11, wherein the converter is configured to obtain the telephone number from a remote database.

46. The computer program product according to claim 28, wherein the longest matching sub-string comprises a longest matching prefix.

47. The computer-implemented method according to claim 29, wherein the longest matching sub-string comprises a longest matching prefix.

48. The system according to claim 30, wherein the longest matching sub-string comprises a longest matching prefix.

49. The computer program product according to claim 1, further comprising a fourth computer code device configured to establish a voice communications channel between the user side and a Web page provider-side using the telephone number.

50. The computer-implemented method according to claim 5, further comprising establishing a voice communications channel between a user-side and a Web page provider-side using the telephone number.

51. The system according to claim 11, wherein the controller further establishes a voice communications channel between a user-side and a Web page provider-side using the telephone number.

52. A computer program product, comprising:
a computer storage medium and a computer program code mechanism embedded in the computer storage medium,
the computer program code mechanism comprising:
a first computer code device configured to obtain a Uniform Resource Locator identifying a Web page currently being displayed to a user by a Web browser of a user-side;
a second computer code device configured to convert, without user intervention, the Uniform Resource Locator into a contact telephone number corresponding to the Web page;
a third computer code device configured to visually identify, without user invention, that the contact telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.

53. A computer-implemented method comprising:

obtaining a Uniform Resource Locator identifying a Web page currently being displayed to a user by a Web browser at a user-side;

converting the Uniform Resource Locator, without user intervention, into a contact telephone number corresponding to the Web page; and

visually identifying, without user intervention, that the contact telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.

54. A telecommunications system comprising:

a receiver configured to obtain a Uniform Resource Locator identifying a Web page currently being displayed to a user by a Web browser of a user-side;

a converter configured to convert, without user intervention, the Uniform Resource Locator into a contact telephone number corresponding to the Web page;

a controller configured to visually identify, without user intervention, that the contact telephone number is known for the Uniform Resource Locator corresponding to the Web page being displayed to the user.